

REMARKS

Claims 1, 3, 4 and 19 are pending in this application. Claims 2 and 5-18 have been cancelled without prejudice or disclaimer. No new matter is added.

Rejection of the Claims under 35 U.S.C. § 102(e).

In the final Office Action mailed on October 16, 2006, claims 1, 3, 4 and 19 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yano et al., U.S. Patent No. 6,649,380 ("the Yano '380 patent"). Applicants filed an Amendment Under 37 C.F.R. § 1.116 on February 16, 2007 in response traversing the rejection on the grounds that the Japanese priority date of the present application predated the U.S. filing date of the Yano '380 patent.

The Examiner issued an Advisory Action on March 15, 2007 in which the rejection of claims 1, 3, 4 and 19 under 35 U.S.C. § 102(e) was initially maintained. However, applicants left a message with the Examiner on March 21, 2007 and pointed out that the rejection was based on the wrong filing date (i.e., the filing date of the Yano '367 patent, not the Yano '380 patent). In response, the Examiner issued a Supplemental Advisory Action on April 4, 2007 and withdrew the rejection of claims 1, 3, 4 and 19 under 35 U.S.C. § 102(e) over the Yano '380 patent in view of the arguments made in applicants' February 16, 2007 response and applicants' concurrent filing of a certified copy of the Japanese prior document for the instant application. Applicants thank the Examiner for his consideration in granting the interview and for issuing the Supplemental Advisory Action withdrawing the rejection of claims 1, 3, 4 and 19 under 35 U.S.C. § 102(e) over the Yano '380 patent.

Rejection of Claims 1, 3, 4 And 19 For Non-Statutory Obviousness-Type Double Patenting.

In the final Office Action mailed on October 16, 2006, claims 1, 3, 4 and 19 were also rejected on the ground of non-statutory obviousness double-patenting as being unpatentable over claim 10 of the Yano '380 patent. Applicants traversed this rejection in the response filed on February 16, 2007 but the Examiner maintained the rejection in both the Advisory Action and the Supplemental Advisory Action. Applicants respectfully request reconsideration of the rejection in view of the following remarks.

The Yano '380 patent discloses the invention in which a compound having a hydroxyl group is added as a molecular weight controlling agent at polymer formation in order to control the molecular weight of polyhydroxyalkanoate (PHA). When such a molecular weight controlling agent is used, one end of the polymer becomes PHA as set forth and described in claim 10 of the Yano '380 patent. Therefore, R₁₇ is as illustrated in claim 10 of the Yano '380 patent, i.e., a monomeric unit. In other words, there is no teaching or example in the Yano '380 patent where a plurality of the monomeric chemical formula (17) in claim 10 of the Yano '380 patent is continuously linked together to form a polymeric moiety.

In contrast, PHA according to the present invention itself forms the repeating unit of a polymer. Therefore, claims 1, 3, 4 and 19 of the present invention which define the repeated unit that is continuously linked together in plural are patentably distinct from claim 10 of the Yano '380 patent. In view of these arguments, applicants respectfully request withdrawal of the rejection and submit that claims 1, 3, 4 and 19 are in condition for allowance.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 1232-5182.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 1232-5182.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: April 16, 2007

By: 

Andrea L. Wayda
Registration No. 43,979

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700
(212) 415-8701

Telephone
Facsimile